

Applicant : Yang, et al
Appl. No. : 09/347,845
Examiner : Bul, Vy Q.
Docket No. : 702583.40

REMARKS

In the Office Action, the Examiner rejected claims 1 and 9 under 35 U.S.C. §103(a) as being unpatentable over Lenker et al. (USP 5,824,041) in view of Martinez et al. (USP 5,453,090); rejected claims 11-20, 37 and 39 under 35 U.S.C. §103(a) as being unpatentable over Lenker et al. In view of Martinez et al. further in view of Estrada et al. (USP 6,193,686), Lodin et al. (USP 5,460,608), and Thornton (USP 5,891,090); and rejected claims 1, 9-18, 20, 37 and 39 under 35 U.S.C. §103(a) as being unpatentable over Sepetka et al. (USP 5,814,062) in view of Martinez et al.

Applicant addressed each of these rejections in its response filed May 9, 2003. The Examiner acknowledged the portion of Applicant's response dealing with the Lenker et al. and Martinez et al. patents, but disagreed, stating:

Lenker et al. disclose a bumper member or an anchor member (258) having a distal end including a blunt edge as illustrated below. Note: in this case blunt edge does not mean "blunt tip."

The Examiner did not acknowledge the portion of Applicant's response concerning the Sepetka et al. and Martinez et al. patents.

These remarks are intended to request reconsideration of the rejections set forth in the Office Action or, alternatively, to clarify the grounds for appeal, if necessary.

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1. Claim Rejections Under 35 U.S.C. 103(a)

a. Claims 1 and 9

Applicant respectfully disagrees with the Examiner's contention that the Lenker et al. patent discloses a bumper member "having a distal end including a blunt edge." The Lenker et al. patent discloses a delivery catheter for a radially compressible tubular prosthesis. The catheter includes a proximal anchor 258 and distal anchor 256 that cooperate to radially compress the prosthesis P, even after the sheath 254 has been fully withdrawn. (See col. 11, ll. 10-15, Figs. 19A-19D). The proximal anchor 258 cannot be a blunt edge, however, because otherwise it would not be capable of compressing the prosthesis P as described. Instead, the proximal anchor must include a structure such as the stay 124 shown in Figs. 13-15. Thus, the Lenker et al. patent does not teach or suggest a bumper member with a distal end "having a blunt edge disposed adjacent the proximal end of the prosthesis for preventing axial displacement of the prosthesis upon retraction of the tubular member with respect to the bumper member." This feature is recited in each of claims 1 and 9 of the present application.

The Examiner's statement that "in this case blunt edge does not mean 'blunt tip'" misses the point. The meaning of the term "blunt edge" in Applicant's claims plainly refers to the "blunt distal edge 42" described in the specification. (See pg. 19, ll. 16-18, Figs. 1B, 4A, and 4B). The sole issue is whether such a "blunt edge" is disclosed or taught by the Lenker et al. patent. Quite simply, it is not. As a result, the obviousness rejection cannot stand.

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Accordingly, Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

b. Claims 11-20, 37 and 39

Claim 11 contains the identical claim limitation stated above concerning the bumper member "having a blunt distal edge disposed adjacent the proximal end of the prosthesis." Claims 12-20, 37 and 39 are all dependent from claim 11, and they therefore contain the same limitation. Accordingly, for the same reasons set forth in part a. above concerning claims 1 and 9, the Examiner has failed to establish a prima facie case of obviousness with regard to claims 11-20, 37 and 39. The rejections of these claims should be withdrawn and these claims should be allowed.

c. Claims 1, 9-18, 20, 37 and 39

The Examiner rejected claims 1, 9-18, 20, 37 and 39 under 35 U.S.C. §103(a) as being unpatentable over Sepetka et al. (USP 5,814,062) in view of Martinez et al. Because neither of the cited patents, either alone or in combination, discloses, teaches, or suggests the subject matter of the claims, reconsideration and withdrawal of the rejections is respectfully requested.

The Sepetka patent describes an occlusive implant delivery assembly including a decoupling or detachment mechanism for separating the implant from the delivery assembly. (See Abstract, Figs. 1-6). The assembly includes a catheter 4 within which an elongated carrier 26 is disposed. A coil 28 is attached to the

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carrier 26 by a coupling 30. Nowhere does the Sepetka patent teach or suggest a bumper member "having a blunt edge disposed adjacent a proximal end of the prosthesis" as recited in each of the rejected claims. As discussed previously, neither does the Martinez patent provide this information. Thus, as above, the Examiner has failed to establish a prima facie case of obviousness of the rejected claims.

In addition, the Examiner has shown no teaching or suggestion that would have motivated a person of ordinary skill in the art to combine the disparate teachings of the Sepetka and Martinez patents in the manner suggested. The Examiner's rejection thus constitutes pure (and improper) hindsight, using Applicants' claims as a guide. For these reasons, the Examiner's rejection of claims 1, 9-18, 20, 37 and 39 should be withdrawn and these claims should be allowed.

These arguments were presented in Applicant's previous response, but were not acknowledged in the pending Final Office Action.

2. Conclusion

In view of the foregoing, it is submitted that the claims presented in this application define patentable subject matter over the cited prior art. Accordingly, reconsideration and allowance of the application is requested.

If the Examiner does not accept the foregoing request for reconsideration and does not allow the claims, Applicant requests a prompt Advisory Action so stating in order that Applicant might file a Notice of Appeal at the earliest possible opportunity.

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Applicant invites the Examiner to contact the undersigned by telephone at (949) 567-6700 if doing so will clarify any issues concerning this application.

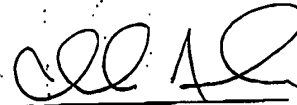
The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 15-0665.

Respectfully submitted,

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Dated: August 21, 2003

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